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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,328	07/31/2001	Edith H. Stern	101.032	5242
28062	7590	06/30/2004	EXAMINER	
BUCKLEY, MASCHOFF, TALWALKAR LLC			BULLOCK JR, LEWIS ALEXANDER	
5 ELM STREET			ART UNIT	
NEW CANAAN, CT 06840			PAPER NUMBER	
			2126	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/919,328	STERN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lewis A. Bullock, Jr.	2126	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims disclose a method for providing a service however there is no statutory entity within the method that performs any of the cited steps therefore the cited teachings appear to be software code.

***Claim Rejections - 35 USC § 112***

2. Claims 58-60 recites the limitation "the service" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over THEIMER (U.S. Patent 5,544,321).

As to claims 1 and 2, THEIMER teaches a method of providing a service (executing an RPC request), comprising: receiving first data (user profile) associated with a user and owned by a first data owner or source (known place / user's home directory) (col. 10, lines 52-62); receiving second data (user's calendar information) associated with the user and owned by a second data owner or source (location in a file system known to the UserAgent) (col. 10, lines 52-62); and determining a service to provide (whether to execute the RPC or not) to the user and providing the service (col. 11, lines 11-40; col. 11, lines 54-67). It would be obvious to one skilled in the art at the time of the invention that the UserAgent use the first and second data in order to determine whether to provide the service because the UserAgent is initialized with the data and serves as a manager for customizing and accessing such data (col. 9, line 64 – col. 10, line 24).

As to claims 3-22 and 27, THEIMER teaches the receiving first and second data in order to determine whether to provide a service wherein the data is state data, application data, real-time data, location data, user preference data, I/O data, and proximity data (col. 10, lines 9-46; col. 10, lines 52-62). THEIMER also teaches that the invention allows for various modifications, variations, and extensions within the scope of the invention (col. 30, lines 11-17). However, THEIMER does not mention other types of data, i.e. facial gesture data, body temperature data, purchase data, news, or weather data. Official Notice is taken in that these types of data are well known in the

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art and would be obvious in view of THEIMER in order to further determine access to a service.

As to claims 23 and 24, THEIMER teaches the receiving first and second data in order to determine whether to provide a service (execute a RPC or return data) wherein the data is state data, application data, real-time data, location data, user preference data, I/O data, and proximity data (col. 10, lines 9-46; col. 10, lines 52-62). THEIMER also teaches that the invention allows for various modifications, variations, and extensions within the scope of the invention (col. 30, lines 11-17). However, THEIMER does not mention charging of a payment for the service. Official Notice is taken in that it is well known in the art that service providers charge a payment for using their service.

As to claims 25 and 26, THEIMER teaches the receiving first and second data in order to determine whether to provide a service (execute a RPC or return data) wherein the data is state data, application data, real-time data, location data, user preference data, I/O data, and proximity data (col. 10, lines 9-46; col. 10, lines 52-62). THEIMER also teaches that the invention allows for various modifications, variations, and extensions within the scope of the invention (col. 30, lines 11-17). However, THEIMER does not mention the service is the displaying of an advertisement. Official Notice is taken in that it is well known in the art that a service is an advertisement that is requested for display.

As to claims 28-31, 33, and 34, THEIMER teaches determining a state (current state of the UserAgent / location) based on the first and second data wherein the state may indicates busy or available (via Boolean value indicating whether the user is available for telephone calls) (col. 11, lines 60-62) and identifying the users to a third party (another client / Location Service) via an alert (callback), if the state corresponds to a target state (col. 12, lines 10-67).

As to claim 32, THEIMER teaches the first and second data is received pull protocol (via locating and reading the information) (col. 10, lines 52-62).

As to claim 35, THEIMER teaches the first and second data is transmitted by a wireless protocol or a wireline protocol (col. 5, lines 59-65; col. 6, lines 27-33).

As to claim 36, THEIMER teaches receiving a service request from the user (col. 11, line 22-26).

As to claim 67, reference is made to a medium that corresponds to the method of claim 1 and is therefore met by the rejection of claim 1 above.

As to claim 69, reference is made to an apparatus that corresponds to the method of claim 1 and is therefore met by the rejection of claim 1 above.

As to claim 71, reference is made to a system that corresponds to the method of claim 1 and is therefore met by the rejection of claim 1 above.

As to claim 37, THEIMER teaches a method to determine a user state (via a RPC), comprising: receiving a first data (user profile) associated with a user and owned by a first data owner (known place / user's home directory) (col. 10, lines 52-62); receiving second data (user's calendar information) associated with the user and owned by a second data owner (location in a file system known of the UserAgent) (col. 10, lines 52-62); determining a state (current state of the UserAgent / location); and identifying the user to a third party (another client / Location Service) if the state corresponds to a target state (state has changed) (col. 12, lines 10-67). It would be obvious to one skilled in the art at the time of the invention that the UserAgent use the first and second data in order to determine whether to determine or change the state because the UserAgent is initialized with the data and serves as a manager for customizing and accessing such data (col. 9, line 64 – col. 10, line 24).

As to claims 38-57 and 60, THEIMER teaches the receiving first and second data in order to determine whether to provide a service wherein the data is state data, application data, real-time data, location data, user preference data, I/O data, and proximity data (col. 10, lines 9-46; col. 10, lines 52-62). THEIMER also teaches that the invention allows for various modifications, variations, and extensions within the scope of



the invention (col. 30, lines 11-17). However, THEIMER does not mention other types of data, i.e. facial gesture data, body temperature data, purchase data, news, or weather data. Official Notice is taken in that these types of data are well known in the art and would be obvious in view of THEIMER in order to further determine access to a service.

As to claims 58 and 59, THEIMER teaches the receiving first and second data in order to determine whether to provide a service (execute a RPC or return data) wherein the data is state data, application data, real-time data, location data, user preference data, I/O data, and proximity data (col. 10, lines 9-46; col. 10, lines 52-62). THEIMER also teaches that the invention allows for various modifications, variations, and extensions within the scope of the invention (col. 30, lines 11-17). However, THEIMER does not mention the service is the displaying of an advertisement. Official Notice is taken in that it is well known in the art that a service is an advertisement that is requested for display.

As to claim 61, 64 and 65, THEIMER teaches determining a state (current state of the UserAgent / location) based on the first and second data wherein the state may indicates busy or available (via Boolean value indicating whether the user is available for telephone calls) (col. 11, lines 60-62) and identifying the users to a third party (another client / Location Service) via an alert (callback), if the state corresponds to a target state (col. 12, lines 10-67).

As to claim 62, THEIMER teaches the receiving first and second data in order to determine whether to provide a service (execute a RPC or return data) wherein the data is state data, application data, real-time data, location data, user preference data, I/O data, and proximity data (col. 10, lines 9-46; col. 10, lines 52-62). THEIMER also teaches that the invention allows for various modifications, variations, and extensions within the scope of the invention (col. 30, lines 11-17). However, THEIMER does not mention charging of a payment for the service. Official Notice is taken in that it is well known in the art that service providers charge a payment for using their service.

As to claim 63, THEIMER teaches the first and second data is received pull protocol (via locating and reading the information) (col. 10, lines 52-62).

As to claim 66, THEIMER teaches the first and second data is transmitted by a wireless protocol or a wireline protocol (col. 5, lines 59-65; col. 6, lines 27-33).

As to claim 68, reference is made to a medium that corresponds to the method of claim 37 and is therefore met by the rejection of claim 37 above.

As to claim 70, reference is made to an apparatus that corresponds to the method of claim 37 and is therefore met by the rejection of claim 37 above.

As to claim 72, reference is made to a system that corresponds to the method of claim 37 and is therefore met by the rejection of claim 37 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (703) 305-0439. The examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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